

DETAILED ACTION

Election/Restrictions by Original Presentation

821.03 [R-3] Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145. Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144

The amendment filed on 4/13/2009 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention because

The newly submitted claims 87-101 directed to the disc identification information indicates, to a playback apparatus, a read-only optical disc to be used in combination with the package area by the playback apparatus to generate a virtual package, the first playlist information includes information defining a playback path comprising a playback section of the first digital stream and a playback section of the second digital stream, and the first playlist information is used in place of second playlist information recorded on the optical disc, by the playback apparatus to generate the virtual package, classified in class 369, subclass 7.

The original claims directed to the secondary recording medium has correspondence information recorded thereon, the correspondence information identifying the first digital stream in correspondence with the second digital stream, and the reading by the first and second reading units are performed based on the correspondence information, classified in class 386, subclass 125.

The original claims and the newly submitted claims are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the original claims do not require “the disc identification information indicates, to a playback apparatus, a read-only optical disc to be used in combination with the package area by the playback apparatus to generate a virtual package, the first playlist information includes information defining a playback path comprising a playback section of the first digital stream and a playback section of the second digital stream, and the first playlist information is used in place of second playlist information recorded on the optical disc, by the playback apparatus to generate the virtual package” of the newly submitted claims. The subcombination, newly submitted claims has separate utility such as “the disc identification information indicates, to a playback apparatus, a read-only optical disc to be used in combination with the package area by the playback apparatus to generate a virtual package, the first playlist information includes information defining a playback path comprising a playback section of the first digital stream and a playback section of the second digital stream,

and the first playlist information is used in place of second playlist information recorded on the optical disc, by the playback apparatus to generate the virtual package. ”

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS**, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. Since this application has been granted special status under the accelerated examination program, **NO** extensions of time under 37 CFR 1.136(a) will be permitted.

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

Art Unit: 2621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/
Examiner, Art Unit 2621

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621